Assistant Commissioner
for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

The Official Action dated October 30, 2002, in the above-identified application sets forth a Requirement for Restriction under 35 U.S.C. §121. The Examiner has determined that the claims of this application are drawn to two inventions which are alleged to be patentably distinct, as follows:

I. Claims 1-8, drawn to a process for continuous casting of film sheets; and

II. Claims 9-20, drawn to a comestible substance having a film.

It is the Examiner's position that the product of claims 9-20 could be made by a materially different process, such as by a batch process, or by spraying the material on the comestible surface.

Election

In response to the above-mentioned requirement, Applicant hereby elects, with traverse, Group II, Claims 9-20, drawn to a comestible substance integrated with an edible film sheet, made by the process of claim 1.

Traversal

Applicants traverse on two grounds. First, the Examiner has incorrectly described the inventions as a distinct product and process of making said product. Second, examination of both Groups would not present an undue search burden. Accordingly, claims 1-20 should be examined together.

MPEP §803 discusses when restriction is proper:

> **CRITERIA FOR RESTRICTION BETWEEN PATENTABLY DISTINCT INVENTIONS**
>
> There are two criteria for a proper requirement for restriction between patentably distinct inventions:

(A) The inventions must be independent (see MPEP § 802.01, § 806.04, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(i)); and

(B) There must be a serious burden on the examiner if restriction is required (see MPEP § 803.02, § 806.04(a) - § 806.04(i), § 808.01(a), and § 808.02).

The MPEP also address specific definitions of Distinctness:

806.05(f) Process of Making and Product Made - Distinctness

A process of making and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (A) that the process as claimed is not an obvious process of making the product and the process as claimed can be used to make other and different products; or (B) that the product as claimed can be made by another and materially different process.

Allegations of different processes or products need not be documented.

A product defined by the process by which it can be made is still a product claim (In re Bridgeford , 357 F.2d 679, 149 USPQ 55 (CCPA 1966)) and can be restricted from the process if the examiner can demonstrate that the product as claimed can be made by another materially different process; defining the product in terms of a process by which it is made is nothing more than a permissible technique that applicant may use to define the invention.

If applicant convincingly traverses the requirement, the burden shifts to the examiner to document a viable alternative process or product, or withdraw the requirement.

(Emphasis added)

In the instant case, the Examiner has held that there are two separate inventions, which are allegedly distinct because "the product as claimed can be made by another and materially different process, such as by a batch process or by spraying the material on the comestible surface." (Restriction requirement dated October 30, 2002).

Applicants submit that the product of claims 9-20 could not be made by a materially different process, and thus is not distinct as defined above. There is no other way to make a continuous, asymmetrical film of the type claimed.

Continuous cast films from aqueous media are by nature smooth on both surfaces. The supported lower dried surface is smooth, and the exposed upper dried surface is smooth. Continuous cast films in general are designed to have smooth surfaces on both sides to implement production of a high

density rolled stock for converting operations.

In the process of the present invention, a paste-like film forming material is passed into the nip between two opposing and appositionally rotating, internally heated drums. This creates a laminar extrusion of the paste through the nip gap. On exit through the gap two things happen. The paste-like material adjacent to the surface of each drum begins to dry, and the drum surfaces begin to diverge from each other. The momentarily contiguous extruded film paste is mechanically stressed and separates. The separation or division of the paste mass caused in this way is not geometrically homogenous because of microscopic inhomogeniety resulting from the microscopic fibrous matrix.

The result is that the dividing surfaces created as the drums diverge generate microscopic protuberances or dendritic projections which dry to produce a surface with a rough texture resulting from microscopic spinney projectile structures, while the opposing surface is relatively smooth.

The resultant asymmetrical film is truly unique, and there is no way to make it as a continuous cast film, suitable for stock roll production.

The Examiner asserts that the claimed film can be made by another and materially different process, such as by a batch process, or by spraying the material on a comestible substance. Applicant disagrees, and will supply experimental evidence that these other processes would result in a different product, if it is necessary.

A batch processed film by it's very nature would be distinct from the film claimed. Batch processed films are produced in separate vessels and thus cannot be continuous.

A film sprayed on a comestible substance would also be distinct from the film claimed. A sprayed film would not have the unique surface characteristics of the films instantly disclosed. For example, in claim 1, (from which all product claims depend), the film must have a side which has

"microscopic protuberances" extending therefrom, and a smooth side. To applicant's knowledge, there is no way that a spraying technique could be used to produce this effect.

Accordingly, applicant submits that the Examiner's holding that the Groups are distinct because the product could allegedly be made by another and materially different process is incorrect. Applicant respectfully requests in the event this restriction requirement be maintained, that the Examiner provides an explanation of how a product as recited in claims 9-20 may practically be made by a different process, as required in MPEP §806.05(f) above.

Secondly, applicants submit that examination of both Groups of inventions would not present an undue search burden to the Examiner. The claims are drafted in product by process format. The product of claims 9-20 is unique due to the distinctive process by which it is made. Therefore, in order to completely search the elected product claims of Group II, the Examiner will be required to search the prior art for the unique process of the Group I claims. Accordingly, a search for Group II would be coextensive with a search of Group I. Therefore there is no undue search burden for the Examiner as a result of examining all claims together.

Request for Rejoinder

Should the Examiner maintain the restriction requirement, and should the elected product later be found allowable, pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), applicant requests that the process claims be rejoined with the product claims. See MPEP §821.04-

> Where product and process claims drawn to independent and distinct inventions are presented in the same application, applicant may be called upon under 35 U.S.C. 121 to elect claims to either the product or process. See MPEP § 806.05(f) and § 806.05(h). The claims to the nonelected invention will be withdrawn from further consideration under 37 CFR 1.142. See MPEP § 809.02(c) and § 821 through § 821.03 . However, if applicant elects claims directed to the product, and a product

claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined....In the event of rejoinder, the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104.

Conclusion

The present election of the claims of Group II is without prejudice to Applicant's right to file a continuing application, as provided under 35 U.S.C. §121, on the subject matter of any claims ultimately held withdrawn from consideration in the application.

Early and favorable action on the merits of this application is respectfully requested.

Respectfully Submitted,
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